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MAR 30 2004

OFFICE OF PETITIONS

In re Non Provisional Application of
Overbeck et al.
Application No.: 09/079,324
Filed: May 14, 1998
Attorney Docket No. A0749/7004

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DECISION GRANTING PETITION

In re Provisional Application of
Overbeck et al.
Application No. 60/183,021
Filed: May 14, 1998
Attorney Docket No. A0749/7004

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This is a decision on the petition filed by facsimile transmission on July 3, 2000, resubmitted September 21, 2000, and supplemented by facsimile transmission on March 26, 2004, requesting under 37 CFR 1.182 or 1.183 that the USPTO vacate the decision of March 21, 2000, which is being treated as (1) a petition under 37 CFR 1.181(no fee) requesting that the actions of OIPE be reviewed and that the above-captioned provisional application be reconverted to non provisional application No. 09/079,324 having its original filing date of May 14, 1998, and (2) a petition under 37 CFR 1.181 to withdraw any holding of abandonment..

The petitions are **granted**.

The decision of March 21, 2000, was mailed in error and is **vacated**.

The instant application papers were deposited on May 14, 2003, as a nonprovisional application filed under 35 U.S.C. § 111(a) and 37 CFR 1.53(b). On June 2, 1998, the Office of Initial Patent Examination (OIPE) sent a Notice stating that the declaration was unsigned, and that various fees were outstanding.

In reply, an executed declaration and the required fees were filed on August 6, 1998, which were consistent with continuing treatment, by applicants, of the instant application papers as a non provisional. However, as former and current counsel agree, the rely also apparently, albeit inadvertently, contained a petition under 37 CFR 1.53(c)(2)(1998) to convert the application papers filed as a non provisional under 37 CFR 1.53(b) to a provisional application under 37 CFR 1.53(c). However, inspection of this file fails to reveal that the original petition was matched with this file (or its predecessor file).

On September 24, 1999, the examiner mailed a communication noting informalities that required correction.

On October 28, 1999, applicants filed a reply to the examiner's first communication.

On January 18, 2000, the examiner mailed a restriction requirement, and set a shortened statutory period for reply.

On February 15, 2000, applicants filed a communication requesting USPTO confirmation that the aforementioned petition for conversion, in essence, would not be considered on the merits. Applicants also included a copy of the apparently previously filed, albeit missing from the contents of this file, petition seeking conversion.

On March 21, 2000, OIPE favorably treated the later-filed copy of the aforementioned petition for conversion, notwithstanding that jurisdiction of the application had long since passed to the Technology Center. The conversion entailed that the former non provisional application was no longer an active file, and as such subsequently filed papers captioned for that file could not physically be matched with that inactive file, which no longer physically existed.¹

On April 17, 2000, as shown by the copy of the itemized postcard receipt filed March 26, 2004, applicants filed via Express Mail: (1) a reply to the outstanding restriction requirement, i.e., an election, (2) a petition and fee (via check No. 537) for a two month extension of time, and (3) a revocation and appointment of power of attorney.. Inspection of relevant USPTO financial records reveals that the extension of time fee was processed by the USPTO on April 20, 2000. However, the original documents filed on April 17, 2000 were not matched with either the non provisional file or even the provisional file.

Petitioners confirm their previous petition asking withdrawal of the petition to convert and request that the USPTO continue to treat the instant application papers as a non provisional application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The decision of March 21, 2000, was clearly issued in error and is **vacated**. The USPTO regrets the delay and inconvenience to applicants. The improper decision will be considered as having no force and effect on the pendency of this application as a non provisional application. It follows that applicants reply of April 17, 2000, tolled the period for reply to the outstanding restriction requirement. As such the non provisional was and remains a pending application. Upon Technology Center processing of that resubmitted reply, this application will be then considered an amended application. Petitioners' concurrent request that the original or subsequent petition(s) be expunged will not be granted. It is the policy of the USPTO to maintain the prosecution history of a given application as complete a record as possible, and retention of all documents pertaining to the unusual aspects of the history of this application would be especially useful in this instance.

The copy of the revocation and power of attorney and change of correspondence address originally filed on April 17, 2000, has been accepted.

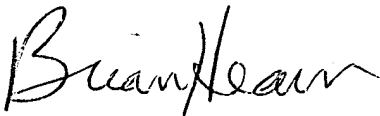
When the IFW is returned to the jurisdiction of the Technology Center, the examiner will consider the resubmitted copy of the timely election originally filed April 17, 2000.

¹ Interestingly, an associate power of attorney filed by former counsel on April 5, 2000, (now having no force and effect) was eventually matched with the resultant provisional.

The application file is being returned to the Office of Initial Patent Examination, Customer Corrections, for further processing as non provisional application No. 09/079,324 filed under 37 CFR 1.53(b) on May 18, 1998. As provisional application No. 60/183,021 will no longer be an active application file number, all further correspondence for this application should be captioned, per 37 CFR 1.5, for non provisional application No. 09/079,324. It is noted that reincarnated non provisional application No 09/079,324 will be scanned as, and remain, an Image File Wrapper (IFW), and will no longer be constituted as a "paper file."

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Telephone inquiries related to OIPE processing should be directed to the OIPE hotline at (703) 308-1202.



Brian Hearn
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Office of the Deputy Commissioner
for Patent Examination Policy